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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,916	12/22/1998	LARRY A. NICKUM	450.251US1	2458

32710 7590 12/12/2003

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EXAMINER

RAO, SHEELA S

ART UNIT	PAPER NUMBER
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2125

25

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/218,916

**Applicant(s)**

NICKUM, LARRY A.

**Examiner**

Sheela Rao

**Art Unit**

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 10, 2003 has been entered.

2. Claims 1-23 are presented for examination.

***Response to Amendment & Declaration***

3. The declaration filed on October 10, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ruckdashel reference (USPN 6,038,542).

4. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Ruckdashel reference. The declaration filed on October 10, 2003 fails to provide sufficient showing of the alleged reduction to practice. The declaration must provide a nexus between evidence in the affidavit and the claimed invention. The declaration or affidavit must show that the details of the claimed invention were produced prior to the effective date. The documents provided in the affidavit merely state that the invention is a type of paging system that uses "simple paging transmitters and paging receivers". The information disclosed does not provide or establish sufficient evidence for reduction to practice because there is not enough evidence that the details of the claimed invention were produced prior to the effective date of the reference of prior art. Furthermore, conception of an invention is not proof of reduction to practice. In addition,

5. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Ruckdashel reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another.

Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The evidence that has been submitted does not show a complete disclosure to another and as well does not show that the requisite means and their interaction is comprehended.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabuchi (USPN 5,822,583) in view of Ruckdashel (USPN 6,038,542).

Tabuchi discloses an event generating and delivering system in a computer system that dynamically generates the event corresponding to the output, and automatically executes the process corresponding to the generated event. The event generating and delivering or notification system of the patented invention includes a data processing system that comprises a notification controller and transceiver, as per instant claims 1, 6, and 7, is shown in Figure 1 of the reference. As for the limitation of "a notification transceiver communicatively connected to the notification controller and capable of transmitting a message containing data", Tabuchi teaches this in column 1 at lines 28-32, wherein it is stated that an "event generating and delivering portion generates an event corresponding to an input data ...". However, Tabuchi does not identify the "generated event" (i.e. notification) as being a "message containing data" about an operation. In this regard, Ruckdashel teaches notification as being in the form of a message which must be communicated as a signal of some form (see column 3: lines 26-32 of Ruckdashel)

Tabuchi fails to teach of a portable transceiver for receiving messages as claimed by the instant invention. The patent to Ruckdashel teaches of a system for notification of a scheduled event through the

use of portable devices such as pagers and wireless telephones. The inclusion of portable communication devices in the event notification system of Tabuchi would allow for better access to the user or respondent. It would have been obvious to one of ordinary skill in the art to have included the portable devices of Ruckdashel to the notification system of Tabuchi at the time the invention was so as to have achieved more flexibility, quicker access, and a more efficient system.

As per the limitations of claims 2-5, Tabuchi teaches the use of graphic and audio output devices as a means of delivery of the event. Additionally, the invention of Ruckdashel also teaches the use of LED, LCD, and audible messages with the use of the portable communication devices.

With regard to claims 8 and 13, the generation of an event from a software application, detecting the event, signaling the notification controller and transmitting a message is taught by Tabuchi in column 1, lines 24-45 and column 4, lines 44-61. In addition, Ruckdashel teaches the use of "signaling software controlling a notification controller coupled to a bus and a transceiver" as can be seen in Figure 1 of the reference of prior art. In Figure 1, Ruckdashel illustrates item 112 as a bus and item 104 as the transceiver. The input/output module for both transmitting and receiving data, item 104, includes "circuitry for interfacing the processor with other devices within the computer system including the display or output device"

Tabuchi as modified by the invention of Ruckdashel would include the limitations of claims 9-10, and 14-15 as it is disclosed by Tabuchi that a number of application programs are run and based on the type of event appropriate processing with respect to the event is output. Ruckdashel teaches the limitation as claimed, see abstract and column 3, line 1, et seq. The limitations of claims 12, 17-20 and 22-23 are obvious to the use of portable transceivers or devices as they are used to notify and/or relay messages in this art area. As to the limitation of claims 11 and 16 wherein the generating of an event comprises an interrupt request, this too is obvious to the function of an application program.

As per the limitation of claim 21 that claims the notification transceiver to operate at a frequency licensed for local use, this limitation is not a technical limitation it is a legal standard. As applicant has already admitted on page 6, lines 18-20, of the instant disclosure, the transmission of signals at licensed frequencies is typical as per licensing by the FCC.

For the reasons stated above, the limitations of the claimed invention are taught by the prior arts of record; thereby, rendering the instant claims unpatentable.

**Conclusion**

8. The continuation under rule 37 CFR 1.114 filed October 10, 2003 and the office action, which was a final rejection in the originally filed case, was mailed May 7, 2003. This would seem to be an adequate amount of time for a response to be filed in the present specification. Although, it would appear a first action final office action would be proper, this office action is not being made final in order to allow the Applicant additional time for response.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (703) 305-9766. The examiner can normally be reached Tuesday - Thursday from 9:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (703) 308-0538.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

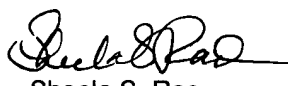
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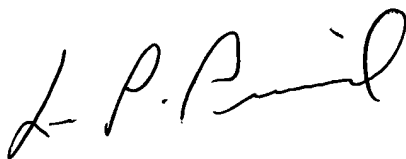
**(703) 872-9306 for Official Communications**

hand-delivered responses should be brought to:

**Receptionist - Sixth Floor  
Crystal Park II, 2121 Crystal Drive, Arlington, Virginia**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
Sheela S. Rao  
December 9, 2003



**LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100**